

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM J. SCHMIDT

Appeal 2005-2193
Application 09/385,405
Technology Center 1700

Decided: December 18, 2006

Before EDWARD C. KIMLIN, CHARLES F. WARREN, and
CATHERINE Q. TIMM, *Administrative Patent Judges*.

TIMM, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

On August 30, 2006, Appellant filed a Request for Rehearing of the Decision of July 13, 2006. In that Decision, the panel sustained the rejections under 35 U.S.C. § 102(b) and under 35 U.S.C. § 103(a) based, in major part, upon Schmidt, Appellant's prior patent. Appellant states that the following points were misapprehended or overlooked in the Decision:

1. The Schmidt reference treats the same or substantially the same starting materials as Appellant (Decision 4).

2. The process of Schmidt treats “first components” as claimed (Decision 4).
3. The two-step filtration process including use of a tangential flow filter described in the Schmidt Declaration is not commensurate-in-scope with the subject matter sought to be patented by claim 71 (Decision 7).

As explained below, Appellant has not persuaded us of any reversible error in our Decision.

Appellant focuses on claim 71, the claim we selected to represent the issues on appeal for the rejections over Schmidt. As pointed out by Appellant, claim 71 is directed to a method of treating a waste material containing gelatin (Request 3). The process involves phase separation wherein some components are present in one layer and other components tend to migrate to the other layer. The layer containing gelatin and a “first component” is treated to remove the “first component.” According to the Specification, the layer containing gelatin is an aqueous layer. Claim 71 designates this layer the “solvent based layer.” According to claim 71, the “first component” is one “which can not effectively be separated from the first liquid into a non-solvent based layer.”

The true issue underlying Appellant’s first two points of contention listed above is one of claim interpretation: Does “first component” as claimed encompass the trace contaminants Schmidt discloses as present in the aqueous layer?

The Decision states that “[a]ny component that remains in the lower aqueous layer (solvent layer) after separation facilitated by sight glass is a ‘first component’ as claimed.” (Decision 5). In other words, the trace

contaminants of Schmidt are “first components” within the meaning of claim 71. During examination, “claims . . . are to be given their broadest reasonable interpretation consistent with the specification, and . . . claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004). In the present case, it is reasonable to read “first component” as including the trace contaminants Schmidt describes as present in the aqueous layer. Appellant’s Specification provides no definition or express disclaimer excluding such trace contaminants. Absent claim language carrying a narrow meaning, we only limit the claim based on the specification when those sources expressly disclaim the broader definition. *In re Bigio*, 381 F.3d 1320, 1324-25, 72 USPQ2d 1209, 1210-11 (Fed. Cir. 2004). We also note that it is reasonable to interpret claim 71 more narrowly than claim 72, a claim dependent on claim 71. “[T]he presence of a dependent claim that adds a particular limitation gives rise to a presumption that the limitation in question is not present in the independent claim.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315, 75 USPQ2d 1321, 1327 (Fed. Cir. 2005)(en banc). While Appellant would have us limit “first components” as recited in claim 71 to those having an affinity for the solvent based layer (Request 3), this affinity limitation is contained in claim 72 and, therefore, it is reasonable to conclude that claim 71 is not so limited. (See also Decision 5.)

Appellant has not persuaded us of a reversible error in the conclusion articulated in the Decision that Schmidt describes treating “first components” as claimed. Moreover, we are not persuaded that the starting materials of Schmidt are different from those treated in the claimed process.

Schmidt treats waste resulting from the same industrial encapsulation processes as Appellant (Compare Schmidt, col. 1, ll. 11-22 to Specification 1:17 to 2:5) containing the same types of contaminants (Compare Schmidt, col. 1, ll. 41-47 and col. 3, ll. 13-25 to Specification 2:19 to 3:3 and 7:1-12).

Appellant further argues that the Schmidt Declaration shows that the Schmidt waste gelatin stream did not contain a “first component” as claimed (Request 10). But, Appellant’s argument is circular in nature and unpersuasive. According to Appellant, because the cartridge filter used in the test did not remove the vitamin E acetate therein, the Schmidt waste stream does not contain a first component (Request 10-11). Claim 71 is not limited to vitamin E acetate, it encompasses “first components” including the trace contaminants disclosed by Schmidt as effectively removed by hot filtration (Schmidt, col. 4, ll. 22-31).

Appellant also argues that the two-step filtration process of the Schmidt Declaration is commensurate-in-scope with the subject matter of claim 71 (Request 11). But, again, Appellant’s argument is dependent on an improperly narrow reading of “first component.” The “first component” claimed is not limited to vitamin E acetate, the tested compound, but instead encompasses the trace contaminants of Schmidt. Moreover, the treatment of step (c) recited in claim 71 is not limited to the two-step filtration process set forth in the Schmidt Declaration but instead is met by the hot filtration step of Schmidt.

With regard to the rejection of claims 74 and 82 over Schmidt in view of Dutre, we note that in accordance with Appellant’s statement that the claims stand or fall together (Br. 10), we selected claim 74 to represent the issues on appeal with regard to the rejection over Schmidt in view of Dutre.

Appellant's arguments directed to claim 82 are untimely and will not be considered. Appellant further argues that there is no motivation for one of ordinary skill in the art to use a tangential flow filter in the process of Schmidt. This is because, according to Appellant, no first component is present in the waste stream of Schmidt. This argument fails for the reasons stated above. Again, this argument is based upon an overly narrow interpretation of "first component" in claim 71. Claim 74 does not further limit "first component."

The subject Request has been granted to the extent that the Decision has been reconsidered, but is denied with respect to making any changes therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

DENIED

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